



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/533, 115	09/25/95	HUTTON	G 649-2

BOOSTEIN & KUDIRKA, PC
ONE BEACON STREET
BOSTON MA 02108

BGM1/0602

EXAMINER

GREGSON, R

ART UNIT 2302

DATE MAILED: 06/02/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/533,115	Applicant(s) Hutton
Examiner Richard J. Gregson	Group Art Unit 2302

Responsive to communication(s) filed on 25 Sep 1995

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-53 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-53 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. Claims 1-53 are presented for examination.

2. A shortened statutory period for response to this action is set to expire three (3) months from the date of mailing of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Information Disclosure Statement

3. In view of the extremely large number of references submitted by the Applicant(s) for consideration of this application, the Applicant(s) are requested to identify any references which have particular significance in the prosecution of this application for further consideration by the Examiner. Applicant(s) should also indicate the specific features, corresponding passages, and figures of such references which are believed to be germane to the invention claimed in the application

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 1-4 are rejected under 35 U.S.C. § 103 as being unpatentable over Civanlar, et al., (US 5,581,552) in view of Morgan, et al., (US 5,524,254). The claimed invention found within Claim 1 consists of a method for establishing point-to-point Internet communications comprising (a) storing in a database a set of IP addresses for on-line nodes, (b) transmitting a query from a node to a server to determine the status of a second node, and © retrieving the IP address of the second node from the database in to establish communication between the two nodes. Civanlar, et al., in 2-3, teaches a multimedia server which uses a communication protocol in which the requesting node sends a request for communication with another node through a address server, which contains an address database, to obtain the address and routing information necessary to complete the communication. Civanlar, et al., is silent regarding the database searching to match the address with the destination node. Morgan, et al, in columns in columns 3-4, teaches the look-up procedure into the database which is performed to retrieve the matching address from the database for use in initiating communications over an network.

It would have been obvious to one of ordinary in the art at the time the claimed invention was made to include an database and search/retrieval mechanism to locate the needed network address because such a mechanism permits the database to be modified over time to allow dynamic address assignment thus reducing the need to larger address identifiers and thus the amount of data that needs to be transmitted with each packet of data.

Regarding Claim 2, the claimed invention adds the further limitation to the invention found within Claim 1 that steps of obtaining the on-line status and IP address of the second node include the steps of: (b1) sending a query to a server, (c1) searching the server's database, (c2) determining the on-line status of the second node, (c3) retrieving the IP address of the second node, (c4) and transmitting the IP address of the second node from the server to the requesting node. As was discussed above regarding Claim 1, Morgan, et al., in columns 3-4, teaches the look-up procedure into the database which is performed to retrieve the matching address from the database for use in initiating communications over a network. It would have been obvious to one of ordinary in the art at the time the claimed invention was made to include an database and search/retrieval mechanism to locate the needed network address because such a mechanism permits the database to be modified over time to allow dynamic address assignment thus reducing the need to larger address identifiers and thus the amount of data that needs to be transmitted with each packet of data.

Regarding Claim 3 and 4, the claimed invention in Claim 3 adds the further limitation to the invention found within Claim 2 that the claimed process generate and transmit an error message which is sent to the requesting node when the second node's status is off-line. The claimed invention Claim 4 adds the further limitation to the invention found within Claim 1 that secondary communications protocol is used when a off-line status is found. Morgan, et al., in columns 13-14 teaches the process of handling

error condition where the requested second node is not available, that the processing terminates gracefully. Implicit within this operation is the transmittal of appropriate messages to the requesting node of this condition with the initiation of error recovery procedures..

8. Claims 5 and 12-16 are rejected under 35 U.S.C. 103 as being unpatentable over Civanlar, et al, (US 5,581,552) in view of Morgan, et al., (US 5,524,254) as applied to claims 1-5 above, and further in view of December, et al. (The World Wide Web Unleased) . The claimed invention in Claim 5 adds the further limitation to the invention found within Claim 4 that performing the secondary communication protocol includes (d1) transmitting an e-mail signal over Internet from the first node with its IP address, (d2) transmitting the message thru the Internet for delivery at the second node, and (d3) transmitting a second IP address to the first node for establishing the point-to-point communications. The combination of Civanlar, et al., and Morgan, et al. teaches the communications mechanism claimed here in utilizing the address server and its database to initiate communications between the two nodes. Neither of these two references teaches the message transport mechanism which is utilized to transmit the various messages between the various processors on the network. December, et al., on pages 6-9 teaches the various message and data types which are readily transported between two nodes attached to the Internet and that each type of message is a format for which blocks of data are sent between different processors. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize Internet e-mail messages as the means to transport various requests between two processors attached to the Internet because it is a well defined and well supported data transport means for moving data between processors across the Internet and that the substitution of e-mail as the transport mechanism

for any other message transport means would be within the ordinary skill of the art as these transport means are equivalent means for moving blocks of data between nodes of the network.

Regarding Claim 12, the claimed invention consists of an independent method claim for establishing point-to point communications comprising transmitting an e-mail signal from the first node via the Internet to the second node, each message containing the appropriate IP address to establish, and using these addresses to establish the point-to-point communication. The claimed invention is a simplified version of the method contained within Claim 1 above with the specification that the messages used to communicate between the first and second nodes be transported using e-mail. The combination of Civanlar, et al., and Morgan, et al. teaches the communications mechanism claimed here in utilizing the address server and its database to initiate communications between the two nodes. Neither of these two references teaches the message transport mechanism which is utilized to transmit the various messages between the various processors on the network. December, et al., on pages 6-9 teaches the various message and data types which are readily transported between two nodes attached to the Internet and that each type of message is a format for which blocks of data are sent between different processors. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize Internet e-mail messages as the means to transport various requests between two processors attached to the Internet because it is a well defined and well supported data transport means for moving data between processors across the Internet and that the substitution of e-mail as the transport mechanism for any other message transport means would be within the ordinary skill of the art as these transport means are equivalent means for moving blocks of data between nodes of the network.

Regarding Claim 13 and 14, the claimed invention adds the further limitation to the invention found within Claim 12 that the process of transmitting the appropriate email signal includes the first step

of generating the signal to be sent before it is transmitted. Implicit within the teaching of Civanlar, et al. Is the step of generating all messages that need top be transmitted to other processors before the message is transmitted using its particular transport means.

Regarding Claim 15, the claimed invention adds the further limitation to the invention found within Claim 12 that processing the e-mail message for delivery thru the Internet consists of the processing the e-mail message using the e-mail server connected to the second processor. Implicit with the teachings of December, et al. is the existence of processes running at both nodes of the Internet that are communicating, which includes the e-mail function, to perform the steps necessary to allow the communication to occur. As such, the transmission of data between two nodes must include the use of a process like a mail server to operate at the receiving end of the communication in order for the communication to be successful. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize Internet e-mail messages on regularly supported e-mail servers as the means to transport various requests between two processors attached to the Internet because it is a well defined and well supported data transport means for moving data between processors across the Internet and that the substitution of e-mail as the transport mechanism for any other message transport means would be within the ordinary skill of the art as these transport means are equivalent means for moving blocks of data between nodes of the network.

Regarding Claim 16, the claimed invention adds the further limitation to the invention found within Claim 12 that step of processing the e-mail signal followed by transmitting a second IP address include the steps of generating a connection signal which is transmitted to the first node along with the second IP address. Civanlar, et al., in column 11, teaches the use of a signal to initiate the connection between the two nodes along with the all necessary address information needed by the nodes. December,

et al., teaches that the communication of these messages can be accomplished using e-mail over the Internet. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize Internet e-mail messages as the means to transport various requests between two processors attached to the Internet because it is a well defined and well supported data transport means for moving data between processors across the Internet and that the substitution of e-mail as the transport mechanism for any other message transport means would be within the ordinary skill of the art as these transport means are equivalent means for moving blocks of data between nodes of the network.

9. Claim 6, which teaches an apparatus claims, fail to teach or define above or beyond Claims 1-5 above and are rejected for the same reasons set forth above in the rejections of Claims 1-5, supra.

10. Claims 7-11, which also teaches a set of apparatus claims, fail to teach or define above or beyond Claims 1-5 above and are rejected for the same reasons set forth above in the rejections of Claims 1-5, supra.

11. Claims 17-18, which teaches a set of apparatus claims, fail to teach or define above or beyond the apparatus found within Claims 12-16 above and are rejected for the same reasons set forth above in the rejections of Claims 12-16, supra.

12. Claims 19-20, which also teaches a set of apparatus claims, fail to teach or define above or beyond the apparatus found within Claims 12-16 above and are rejected for the same reasons set forth above in the rejections of Claims 12-16, supra.

13. Claim 21, which teaches a computer program product claim, fail to teach or define above or beyond Claims 1-5 above and are rejected for the same reasons set forth above in the rejections of Claims 1-5, supra.

14. Claim 22, which teaches a computer program product claim, fail to teach or define above or beyond Claims 12-16 above and are rejected for the same reasons set forth above in the rejections of Claims 12-16, supra.

15. Claims 23-25, which also teaches a set of apparatus claims, fail to teach or define above or beyond Claims 1-5 above and are rejected for the same reasons set forth above in the rejections of Claims 1-5, supra.

16. Claims 26-31, which teaches a set of method claims, fail to teach or define above or beyond the apparatus found within Claims 1-5 above and are rejected for the same reasons set forth above in the rejections of Claims 1-5, supra.

17. Claims 32-42, which also teaches a set of method claims, fail to teach or define above or beyond the apparatus found within Claims 12-16 above and are rejected for the same reasons set forth above in the rejections of Claims 12-16, supra.

18. Claims 43-53, which teaches a set of computer program product claims, fail to teach or define above or beyond the apparatus found within Claims 12-16 above and are rejected for the same reasons set forth above in the rejections of Claims 12-16, supra.

Conclusion

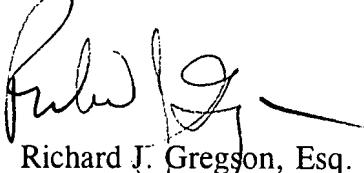
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Heylighen teaches the basics of Internet communication and the addressing means used therein.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard J. Gregson whose telephone number is (703) 305-4392. The examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:30 p.m., as well as on alternate Fridays during these same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alyssa H. Bowler, can be reached on (703) 305-9702. The fax phone number for this Group is (703) 308-5358.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9700.


Richard J. Gregson, Esq.
Patent Examiner
Art Unit 2302

May 22, 1997


MARK H. RINEHART
PATENT EXAMINER
GROUP 2300

